



11-21-06

JFW

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November 18th, 2006

Commissioner for Patents
ATTN: Cesar B. Paula
PO Box 1450
Alexandria, VA 22313-1450

re: Patent Application 10/751,021, reply to determination of restriction

Dear Mr. Paula,

I am writing in in response to your communication of October 19, 2006, which was a Notice of Non-Compliant Amendment (37.CFR 1.121).

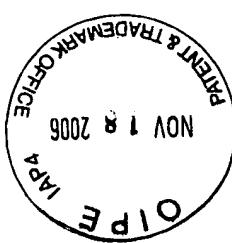
I have enclosed the "clean claims" listing that you have requested. I also have enclosed a copy of my correspondence to you dated July 18, 2006, wherein I responded to your determination that the application was subject to restriction. In that correspondence, I claimed a "Traverse of Requirement to Restrict" per MPEP 809. I have not had a response from you regarding that correspondence and traversal. While I have withdrawn certain claims as seen in the clean listing of claims enclosed per your determination, I have done so with the proviso that I still await your response on the traversal of the restriction determination. If you agree that the two inventions that you determined in your restriction indeed form a distinct subcombination, then I will want to reinstate the claims that I have withdrawn in the enclosed clean listing.

Thank you very much, I await your response.

Sincerely,



Christopher Bohn



COPY

Christopher Bohn
134 Woodbine Drive
Mill Valley, CA 94941
(415)380-8832

July 18th, 2006

Commissioner for Patents
ATTN: Cesar B. Paula
PO Box 1450
Alexandria, VA 22313-1450

re: Patent Application 10/751,021, reply to determination of restriction

Dear Mr. Paula,

I am writing in response to your communication to me dated 6/19/2006, pertaining to Application No. 10/751,021. In that communication, you determined that claims 1-30 are subject to restriction and request an election on my part.

In the restriction, you have determined that the claims in the application form two separate and distinct inventions:

Group I: Claims 1-5, 13-20, 28-30 are drawn to the creation of a list of URLs.

Group II: Claims 6-12 and 21-27 are drawn to obtaining metadata from a media file, classified in class 715, subclasses 500.1, 501.1 and 707/100, 102.

ELECTION

Per the rules given in MPEP 818 and 822, I elect to pursue the claims of Group II in this application, which encompass Claims 6-12 and 21-27 as given above.

I intend to file a divisional application for Group I. However, I believe that per MPEP 809, the claims in Group II are dependent on claims in Group I, and vice versa, and thus the two inventions are linked and not wholly distinct, contrary to your determination. I will explain why (see Traverse of Requirement to Restrict).

RESPONSE TO DETAILED ACTION POINTS

1. Agreed.
2. I agree that claims 1, 6, 13, 16, 21 and 28 are independent claims.
3. I disagree (see Traverse of Requirement to Restrict below)
4. In point 4, you note that Inventions I and II are related as subcombinations usable together in a single combination, and that such subcombinations are distinct if they are shown to be separately usable. I agree with this, but disagree that all subcombinations are indeed distinct as you determine in Point 5 (See Traverse of Requirement to Restrict below).
5. In point 5, you determine that restriction for examination purposes is proper because Inventions I and II are distinct for the reasons given in point 3, and that they have acquired a separate status in the art as shown by the different classifications that you have assigned to them. I disagree with your finding, and will argue that

Inventions I and II are linked by certain claims and as such fall under MPEP 809. (See Traverse of Requirement to Restrict below).

6. In point 6, you determine that distinct and that a search for Group I is not required for Group II, and vice versa. I will argue that Group I and Group II are linked in certain subcombinations, and as such require a mutual search (see Traverse of Requirement to Restrict below).
7. Point 7 is noted but is not applicable in this case, since I am the sole inventor of all claims in the application, and any election would not change the named inventors.

TRAVERSE OF REQUIREMENT TO RESTRICT

I disagree with the determination you make in Points 5 and 6 that the claims 1-30 actually form two separate invention groups, Group I and Group II (which in your communication you refer to as Group I/II and Invention I/II interchangeably, as I will in this letter to you). While I agree with you that there are certain aspects of the Group I and Group II inventions that are separate and distinct, I believe that there are certain claims in Group II that are dependent on Group I and vice versa, thus linking the Group I and Group II inventions. Per MPEP 809, these claims link the two Groups I and II and as such the claims of Group I and II should be rejoined.

I would agree that Invention I and Invention II are indeed separately usable in certain instances, but there is an important instance where the two are linked, and this is reflected in the claims. Consider the instance where you are listening to a podcast (a downloadable digital audio file) that is concerned with a certain topic. You know of content that is retrievable from the internet via URLs and wish said content to be associated with the podcast so that others listening to the same podcast can access the same information. In this case, Invention I is used to create a "WebPipe" consisting of those URLs (as given in the claims that you have assigned to Group I), and Invention II is used to associate that WebPipe with the podcast (claims that you have assigned to Group II). In this case the two together form a subcombination that has distinct utility but which is not possible by the use of one of either inventions alone without the other. The two Groups I and II together have in combination a distinct utility that is reflected in the claims, and which utility would not be covered or understandable if the claims are divided into two separate and distinct inventions. Specifically, I direct you attention to Claim 27, which is a Group II claim that references a "WebPipe" which is a product of Group I claims, and not understandable without the context of the Group I claims. Furthermore, Claim 14 (which you assign to Group I) references Claim 12 (which you assign to Group II). Thus there are claims in Group I that reference claims in Group II, and vice versa. I believe that per MPEP 809, the claims of Group I should be rejoined to the elected claims of Group II.

In summation, I believe the you were in error in your determination that a restriction of the claims into two distinct inventions is proper for the reasons above, and ask that you reconsider and rejoin the claims into one application.

Sincerely,

Christopher E. Bohn